

REMARKS

Claims 1 and 38-74 are pending in the Application. Claims 60, 65, and 70 have been amended. Claim 74 has been added. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

The Objection

Claim 70 was indicated to be allowable if rewritten in an independent form. Claim 70 was accordingly objected to because of its dependency on a rejected base claim.

Claim 70 has been rewritten in an independent form, as requested. Thus, it is respectfully submitted that claim 70 is allowable. Applicant respectfully submits that claim 60 (being directed to similar subject matter as claim 70) is allowable for similar reasons. Thus, claim 60 has also been rewritten in an independent form.

The Rejections

Claims 1, 38-69, and 71-73 were rejected under 35 U.S.C. § 103(a) as obvious over Ruppert (US 5,640,002) in view of Hacker (US 6,621,942).

The Applicant respectfully traverses the rejections. The references, taken alone or in combination, do not teach or suggest the recited features and relationships.

Claim 1

The Action admits that Ruppert does not teach or suggest "storing a signature image within the hand held unit itself." That is, the Office admits that Ruppert does not teach or suggest step (a). Furthermore, Applicant respectfully submits that Ruppert does not teach or suggest recited step (b).

Ruppert does not teach or suggest wirelessly transmitting an electronic signature to a merchant system during a transaction. Where does Ruppert teach or suggest the process of (and the structure necessary for) transmitting an electronic signature to a merchant system during a payment for a store purchase, especially in light of the Office's admission that Ruppert does not even store a signature image before it can be transmitted? In Ruppert, information stored on a credit card's magnetic strip can be transmitted to the store computer during checkout. However, there is no indication in Ruppert that an electronic signature is on a magnetic strip (or a credit card or a smart card). That is, Ruppert does not teach or suggest that an electronic signature is transmitted or used during a check out.

Contrarily, Ruppert teaches away from a user transmitting an electronic signature during a merchant transaction. Ruppert's disclosed teachings of using electronic signatures are not for applications directed to check out. Instead, these teachings are directed to applications such as UPS (delivery service) route work, with time and date stamps on electronic signatures captured from persons to whom deliveries have been made (col. 25, line 60 to col. 26, line 9). The Office cannot add to Ruppert what Ruppert does not explicitly or inherently teach, which is the current situation.

Ruppert's customer (shopper) does not transmit an electronic signature during a merchant transaction. In Ruppert the customer has to go to a checkout clerk at a checkout terminal to make payment and receive security tag deactivation. Credit authorization for the purchase is carried out in a conventional manner (col. 32, lines 58-66). Additionally, in alternative (and equal) embodiments, the customer can swipe his card through a card reader at the checkout terminal (col. 34, lines 43-47), which is a further indication that transmitting an electronic signature is not taught or suggested. In Ruppert a customer has to be located at a checkout terminal. Ruppert needs a checkout clerk at a checkout terminal in order for the customer to pay (and sign for a credit payment). Thus, even if it were somehow possible (which it isn't) for the customer to take the further action and time to transmit an electronic signature at checkout, there would be no reasonable purpose for the customer to do so. Rather, it would have been quicker for the customer, who is already at the checkout terminal, to sign a credit slip, which apparently is how Ruppert's credit checkout process proceeds. The required further action and time it would take to transmit an electronic signature (if somehow even possible) would be contrary to Ruppert's desire for a speedy checkout.

Hacker cannot alleviate the deficiencies of Ruppert as it does not teach or suggest the recited features which are not found in Ruppert. Hacker (like Ruppert) teaches capturing an electronic signature with respect to delivering goods (col. 9, line 65 to col. 10, line 25) with a delivery vehicle (col. 10, lines 37-38). Hacker further teaches a device that can be used in verifying a written signature. The device can receive a written signature which can be compared to an authorized signature already stored in the device. In Hacker a signature stored in the module (3000) can be transmitted to the receiving module (3010) (col. 11, lines 5-8). However,

the transmitting of the signature is not done wirelessly, but via physical coupling means (col. 9, lines 25-31). Even if it were somehow possible to modify Ruppert with the teaching of Hacker, the combination at best would have only resulted in providing Ruppert with the ability to verify a written signature.

Hacker does not teach or suggest wirelessly transmitting an electronic signature. Nor does Hacker (like Ruppert) teach or suggest transmitting an electronic signature to a merchant system during a transaction. Thus, the combined references do not teach or suggest wirelessly transmitting an electronic signature to a merchant system during a transaction.

The Applicant respectfully submits that the attempt to modify Ruppert to include wirelessly transmitting an electronic signature to a merchant system during a transaction is based solely on hindsight reconstruction of Applicant's claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992).

The Office has not established a *prima facie* showing of obviousness. Nor would the combination of references (if somehow possible) have resulted in the recited invention. As previously discussed, at best the combination (if somehow possible) would have only resulted in providing Ruppert with Hacker's ability to verify a written signature. The previously discussed deficiencies in Ruppert would still remain. It follows that it would not have been obvious to one of ordinary skill in the art to have modified Ruppert with Hacker in the manner alleged to have produced the recited invention.

Claim 61

Applicant's remarks in support of the patentability of claim 1 are incorporated by reference. As previously discussed, the combined references do not teach or suggest storing an electronic signature and wirelessly transmitting the electronic signature. The references further do not teach or suggest approving a transaction responsive to a wirelessly received electronic signature and a written signature corresponding in a comparison. Where do the references link a transaction approval to wirelessly receiving an electronic signature?

Where do the references teach or suggest wirelessly receiving a transmitted electronic signature? Where do the references teach or suggest comparing this received electronic signature to an actual written signature? Where do the references teach or suggest approving a transaction in response to these compared signatures corresponding? The combined references don't teach or suggest the recited features. Thus, the Office has not established a *prima facie* showing of obviousness.

Ruppert is not concerned with, has no need for, and makes no mention of comparing signatures. Hacker cannot alleviate the deficiencies of Ruppert as it does not teach or suggest the recited features which are not found in Ruppert. Hacker only compares electronic signatures. Hacker does not compare an electronic signature to an actual written signature. Hacker even uses a "wooden" stylus to enter (i.e., press) a signature onto the digitizer input screen (3025) (col. 9, lines 55-56). Hacker does not receive an electronic signature wirelessly. Nor does Hacker compare a wirelessly received electronic signature to an actual written signature. Nor does Hacker approve a transaction responsive to correspondence of a wirelessly received electronic signature and an actual written signature. Thus, modification of Ruppert with the teaching of

Hacker (if somehow possible) would not have resulted in the recited invention. The Office has not established a *prima facie* showing of obviousness.

Claim 65

Applicant's remarks in support of the patentability of claim 1 are incorporated by reference. For reasons previously discussed, the combined references do not teach or suggest the features and relationships of the recited hand-held user device and merchant system. The Action admits that Ruppert does not teach or suggest an electronic signature stored in the memory of a portable hand-held user device. As previously discussed, the references do not teach or suggest wirelessly transmitting or wirelessly receiving an electronic signature. The combined references further do not teach or suggest the recited hand-held user device and merchant system relationship, where the merchant system during a transaction can wirelessly receive an electronic signature transmitted from the user device (which includes a memory having an electronic signature stored therein). Nor do the references teach or suggest an electronic signature as user authorization in a transaction. The Office has not established a *prima facie* showing of obviousness. Modification of Ruppert with the teaching of Hacker in the manner alleged would not have produced the recited invention.

The New Claim

Claim 74

The subject matter of claim 74 finds basis in original claim 70 (and claims 54, 69, 72, and 73). The references, taken alone or in combination, do not teach or suggest the recited apparatus.

The Dependent Claims

Each of the dependent claims depends directly or indirectly from an independent claim. The Applicant has shown independent claims to be allowable. "If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious" (MPEP 2143.03). *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, it is asserted that the dependent claims are allowable on the same basis.

Furthermore, each dependent claim additionally recites specific features and relationships that patentably distinguish the claimed invention over the applied art. For example, claims 47 and 68 are associated with a user card having a programmable memory and an ATM. Applicant respectfully challenges (MPEP § 2144.03) the alleged well known teaching of "use of ATM cards for effecting transactions in a shopping environment", especially with respect to the allegation of using a user card having a programmable memory "in an ATM environment . . . for shopping." The Action's allegations are not based on any evidence in the record. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

None of the references, taken alone or in combination, discloses or suggests the features and relationships that are specifically recited in the dependent claims. Thus, it is respectfully submitted that the dependent claims are further allowable due to the recitation of such additional features and relationships.

Fees For Additional Claims

Please charge the fees associated with the submission of three additional independent claims (\$258) and one claim in excess of twenty claims (\$18) and any other fee due to Deposit Account 09-0428.

Conclusion

Each of Applicant's pending claims specifically recites features and relationships that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Applicant's invention. Allowance of all of Applicant's pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,



Ralph E. Jocke Reg. No. 31,029
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000